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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/761,191	01/18/2001	Hiroyuki Kumakura	108379	6457

25944 7590 06/19/2003

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EXAMINER

MCCLENDON, SANZA L

ART UNIT	PAPER NUMBER
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1711

DATE MAILED: 06/19/2003

13

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/761,191

Applicant(s)

KUMAKURA, HIROYUKI

Examiner

Sanza L McClendon

Art Unit

1711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2 and 9 is/are rejected.
- 7) ☒ Claim(s) 3-7 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☒ Interview Summary (PTO-413) Paper No(s) 13.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

Interview Summary	Application No.		Applicant(s)	
	09/761,191		KUMAKURA, HIROYUKI	
	Examiner		Art Unit	
	Sanza L McClendon		1711	

All participants (applicant, applicant's representative, PTO personnel):

(1) Sanza L McClendon.

(3) _____.

(2) James Voeller.

(4) _____.

Date of Interview: 3 March 2003.

Type: a) ☒ Telephonic b) ☐ Video Conference

c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☐ No.

If Yes, brief description: _____.

Claim(s) discussed: 1 and 9.

Identification of prior art discussed: n/a.

Agreement with respect to the claims f) ☐ was reached. g) ☐ was not reached. h) ☒ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: Applicant called to discuss claims 1 and 9, examiner referred applicant to the adhesive compositions taught by Takami et al (6,166,101 and 5,721,020). Takami et al, per example, appears to generically disclose applicant's claimed invention--see examples 1 and 5.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

Examiner's signature, if required

Summary of Record of Interview Requirements

Manual of Patent Examining Procedure (MPEP), Section 713.04, Substance of Interview Must be Made of Record

A complete written statement as to the substance of any face-to-face, video conference, or telephone interview with regard to an application must be made of record in the application whether or not an agreement with the examiner was reached at the interview.

Title 37 Code of Federal Regulations (CFR) § 1.133 Interviews

Paragraph (b)

In every instance where reconsideration is requested in view of an interview with an examiner, a complete written statement of the reasons presented at the interview as warranting favorable action must be filed by the applicant. An interview does not remove the necessity for reply to Office action as specified in §§ 1.111, 1.135. (35 U.S.C. 132)

37 CFR §1.2 Business to be transacted in writing.

All business with the Patent or Trademark Office should be transacted in writing. The personal attendance of applicants or their attorneys or agents at the Patent and Trademark Office is unnecessary. The action of the Patent and Trademark Office will be based exclusively on the written record in the Office. No attention will be paid to any alleged oral promise, stipulation, or understanding in relation to which there is disagreement or doubt.

The action of the Patent and Trademark Office cannot be based exclusively on the written record in the Office if that record is itself incomplete through the failure to record the substance of interviews.

It is the responsibility of the applicant or the attorney or agent to make the substance of an interview of record in the application file, unless the examiner indicates he or she will do so. It is the examiner's responsibility to see that such a record is made and to correct material inaccuracies which bear directly on the question of patentability.

Examiners must complete an Interview Summary Form for each interview held where a matter of substance has been discussed during the interview by checking the appropriate boxes and filling in the blanks. Discussions regarding only procedural matters, directed solely to restriction requirements for which interview recordation is otherwise provided for in Section 812.01 of the Manual of Patent Examining Procedure, or pointing out typographical errors or unreadable script in Office actions or the like, are excluded from the interview recordation procedures below. Where the substance of an interview is completely recorded in an Examiners Amendment, no separate Interview Summary Record is required.

The Interview Summary Form shall be given an appropriate Paper No., placed in the right hand portion of the file, and listed on the "Contents" section of the file wrapper. In a personal interview, a duplicate of the Form is given to the applicant (or attorney or agent) at the conclusion of the interview. In the case of a telephone or video-conference interview, the copy is mailed to the applicant's correspondence address either with or prior to the next official communication. If additional correspondence from the examiner is not likely before an allowance or if other circumstances dictate, the Form should be mailed promptly after the interview rather than with the next official communication.

The Form provides for recordation of the following information:

- Application Number (Series Code and Serial Number)
- Name of applicant
- Name of examiner
- Date of interview
- Type of interview (telephonic, video-conference, or personal)
- Name of participant(s) (applicant, attorney or agent, examiner, other PTO personnel, etc.)
- An indication whether or not an exhibit was shown or a demonstration conducted
- An identification of the specific prior art discussed
- An indication whether an agreement was reached and if so, a description of the general nature of the agreement (may be by attachment of a copy of amendments or claims agreed as being allowable). Note: Agreement as to allowability is tentative and does not restrict further action by the examiner to the contrary.
- The signature of the examiner who conducted the interview (if Form is not an attachment to a signed Office action)

It is desirable that the examiner orally remind the applicant of his or her obligation to record the substance of the interview of each case unless both applicant and examiner agree that the examiner will record same. Where the examiner agrees to record the substance of the interview, or when it is adequately recorded on the Form or in an attachment to the Form, the examiner should check the appropriate box at the bottom of the Form which informs the applicant that the submission of a separate record of the substance of the interview as a supplement to the Form is not required.

It should be noted, however, that the Interview Summary Form will not normally be considered a complete and proper recordation of the interview unless it includes, or is supplemented by the applicant or the examiner to include, all of the applicable items required below concerning the substance of the interview.

A complete and proper recordation of the substance of any interview should include at least the following applicable items:

- 1) A brief description of the nature of any exhibit shown or any demonstration conducted,
- 2) an identification of the claims discussed,
- 3) an identification of the specific prior art discussed,
- 4) an identification of the principal proposed amendments of a substantive nature discussed, unless these are already described on the Interview Summary Form completed by the Examiner,
- 5) a brief identification of the general thrust of the principal arguments presented to the examiner,
(The identification of arguments need not be lengthy or elaborate. A verbatim or highly detailed description of the arguments is not required. The identification of the arguments is sufficient if the general nature or thrust of the principal arguments made to the examiner can be understood in the context of the application file. Of course, the applicant may desire to emphasize and fully describe those arguments which he or she feels were or might be persuasive to the examiner.)
- 6) a general indication of any other pertinent matters discussed, and
- 7) if appropriate, the general results or outcome of the interview unless already described in the Interview Summary Form completed by the examiner.

Examiners are expected to carefully review the applicant's record of the substance of an interview. If the record is not complete and accurate, the examiner will give the applicant an extendable one month time period to correct the record.

Examiner to Check for Accuracy

If the claims are allowable for other reasons of record, the examiner should send a letter setting forth the examiner's version of the statement attributed to him or her. If the record is complete and accurate, the examiner should place the indication, "Interview Record OK" on the paper recording the substance of the interview along with the date and the examiner's initials.

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DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. The request filed on June 5, 2003 for a Request for Continued Examination (RCE) under 37 CFR 1.114 is acceptable and a RCE has been established. Applicant's request for reconsideration of the finality of the rejection of the last Office action is persuasive and, therefore, the finality of that action is withdrawn. The amendment to claims 1, 8, and 9 as requested in the paper received January 24, 2003 has been entered. An action on the RCE follows.

Response to Arguments

2. Applicant's arguments with respect to claims 1-7 have been considered but are moot in view of the new ground(s) of rejection.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless -

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in-

(1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effect under this subsection of a national

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application published under section 122(b) only if the international application designating the United States was published under Article 21(2) (a) of such treaty in the English language; or

(2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that a patent shall not be deemed filed in the United States for the purposes of this subsection based on the filing of an international application filed under the treaty defined in section 351(a).

4. Claim 9 is rejected under 35 U.S.C. 102(e) as being anticipated by Takami et al (6,166,101).

Takami et al teaches ultraviolet curing coatings compositions for cans. Said compositions comprise (A) 10-85 parts by weight of a compound having alicyclic epoxy group(s) in the molecules (B) 5-60 parts by weight of compound having an oxetane ring in a specific structure, (C) 5-60 parts by weight of a compound having an oxetane ring and a hydroxyl groups in the molecule, (D) 5-60 parts by weight of a compound having either at least two oxetane ring(s) and epoxy group(s) in the molecule, and (E) 0.01 to 20 parts by weight of a cation-polymerization initiator. Per example 1, Takami et al teaches a composition comprising 40 parts by weight of 3,4-epoxycyclohexylmethyl-3, 4-epoxycylcolhexane carboxylate, 20 parts by weight of the compound having the formula found in line 35, 20 parts of 3-ethyl-3hydroxymethloxyetane, 20 parts of the compound having the formula found in line 46, 6 parts by weight of Cyracure UVI-6990, and small amounts of additives. This appears to anticipate applicant's claim 9 because Takami et al teaches an adhesive composition comprising an insulating resin (3,4-epoxycyclohexylmethyl-3, 4-epoxycylcolhexane carboxylate); a photopolymerization initiators (Cyracure UVI-6990); xylene dioxetane as the oxetane compound (see the formula in line 46 of example 1, and 3-ethyl-3-hydroxymethloxetane. Takami et al is deemed to teach an adhesive

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composition because it is a coating composition that adheres (bonds to once cured) to a substrate (i.e. a can).

5. Claim 9 is rejected under 35 U.S.C. 102(b) as being anticipated by Takami et al (JP 11-152441).

Takami et al US 6,166,101 is being used as the English language equivalent to JP 11-152441.

Takami et al teaches ultraviolet curing coatings compositions for cans. Said compositions comprise (A) 10-85 parts by weight of a compound having alicyclic epoxy group(s) in the molecules (B) 5-60 parts by weight of compound having an oxetane ring in a specific structure, (C) 5-60 parts by weight of a compound having an oxetane ring and a hydroxyl groups in the molecule, (D) 5-60 parts by weight of a compound having either at least two oxetane ring(s) and epoxy group(s) in the molecule, and (E) 0.01 to 20 parts by weight of a cation-polymerization initiator. Per example 1, Takami et al teaches a composition comprising 40 parts by weight of 3,4-epoxycyclohexylmethyl-3, 4-epoxycylcolhexane carboxylate, 20 parts by weight of the compound having the formula found in line 35, 20 parts of 3-ethyl-3-hydroxymethloxetane, 20 parts of the compound having the formula found in line 46, 6 parts by weight of Cyracure UVI-6990, and small amounts of additives. This appears to anticipate applicant's claim 9 because Takami et al teaches an adhesive composition comprising an insulating resin (3,4-epoxycyclohexylmethyl-3, 4-epoxycylcolhexane carboxylate); a photopolymerization initiators (Cyracure UVI-6990); xylene dioxetane as the oxetane compound (see the formula in line 46 of example 1, and 3-ethyl-3-hydroxymethloxetane. Takami et al is deemed to teach an adhesive composition because it is a coating composition that adheres (bonds to once cured) to a substrate (i.e. a can).

6. Claims 1 and 2 are rejected under 35 U.S.C. 102(b) as being anticipate by Takami et al (5,721,020).

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Takami et al teaches ultraviolet curing coatings compositions for cans. Said compositions comprise (A) a cationic-polymerizable compound, (B) a compound having at least one oxetane ring in the molecule, (C) a cationic initiator which generates a cation when irradiated with ultraviolet rays, and (D) a lubricity imparting agent. Per example 5, Takami et al teaches a composition comprising 80 parts by weight of 3,4-epoxycyclohexylmethyl-3, 4-epoxycylcolhexane carboxylate, 20 parts by weight of the compound of formula 16 found in column 14, line 59, 6 parts by weight of Cyracure UVI-6990, and various amounts of other additives. This appears to anticipate applicant's claims 1-2 because Takami et al teaches an adhesive composition comprising an insulating resin (3,4-epoxycyclohexylmethyl-3, 4-epoxycylcolhexane carboxylate); a photopolymerization initiators (Cyracure UVI-6990); and an a bis ((1-ethyl (3-oxetanyl)) methyl) ether as the oxetane compound (see the formula in column 14, line 59). Takami et al is deemed to teach an adhesive composition because it is a coating composition that adheres (bonds to once cured) to a substrate (i.e. a can).

Allowable Subject Matter

7. Claims 3-7 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

8. The following is a statement of reasons for the indication of allowable subject matter: The prior art fails to teach an adhesive composition of the type in claim 1 that additionally comprises electrically conductive particles. Nor does the prior art teach the adhesive composition as found in claim as part of a connected structure, wherein electrodes on a plastic substrate and on a circuit board that are facing each other and connected by said adhesive composition.

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Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanza L McClendon whose telephone number is (703) 305-0505. The examiner can normally be reached on Monday through Friday 8:00 to 4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (703) 308-2462. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0657.

Sanza L McClendon

Examiner

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SMc

June 12, 2003



James J. Seidleck
Supervisory Patent Examiner
Technology Center 1700